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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,952	01/15/2002	William Kress Bodin	AUS920010851US1	4415

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EXAMINER	
NGUYEN, DUSTIN	
ART UNIT	**PAPER NUMBER**
2154	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/046,952	BODIN ET AL.	
	Examiner	Art Unit	
	Dustin Nguyen	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-24 are presented for examination.

Response to Arguments

2. In view of the Appeal Brief filed on 04/07/2006, PROSECUTION IS HEREBY REOPENED. A new non-final Office Action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Specification

3. The disclosure is objected to because of the following informalities: disclosure discloses the encoding (314) but there is no label of 314 in Figures 1b and 5.

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/047,018 [hereinafter '018 application]. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Taking claim 1 as an exemplary claim, the '018 application contains the subject matter claimed in the instant application. As per claim 1, both applications are claiming common subject matter, as follows:

A method of email administration comprising the steps of:

receiving in a transcoding gateway ...;

finding, in dependence upon the domain identification ...; and

sending at least one of the email display capability attributes to the sender.

The claim of instant application do not specifically disclose receiving in a transcoding gateway from a client device one or more email display status attributes as described in the claim 1 of the '018 application but the Toyoda reference discloses a system that makes inquiry about the capability, which a destination possesses, to a local server. The response of capability information is sent to the local server [Figures 7 and 17; col 3, lines 17-20; and col 8, lines 47-55]. It would have been obvious to a person skill in the art at the time the invention was made to receive capability information at the server as taught by Toyoda for all the reasons disclosed by Toyoda such as, "the capability information of a destination terminal can be surely obtained by a terminal on a transmitter side".

As per independent claims 8, 15 and 22, they are also directed to the same subject matter recited in claim 1 above. Accordingly, they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

As per dependent claims 2-7, 9-14, 16-21, 23 and 24 of the instant application, they contain similar subject matter as claims 2-7, 9-14, 16-21 of the '018 application. Accordingly, they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following terms lack antecedent basis:

I. the capability request - claims 1, 8, 15 and 22.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 8 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated over Toyoda [US Patent No 6,335,966].

10. As per claim 1, Toyoda discloses the invention substantially as claimed including a method of email administration comprising the steps of:

receiving in a transcoding gateway from a sender an email display capability request [i.e. makes inquiry about capability information of a desired destination terminal] [Figures 7 and 17; col 7, lines 47-col 8, lines 14], wherein the request comprises a domain identification [i.e. the domain name] [col 8, lines 5-33];

finding, in dependence upon the domain identification, at least one email display capability record for the domain [i.e. gives a response of capability information of the desired destination terminal] [Figures 7 and 17; and col 8, lines 47-55], wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain [i.e. resolution, paper size, color, etc...] [Figure 5; and col 6, lines 43-65]; and

sending at least one of the email display capability attributes to the sender [i.e. transmit the obtained capability information of the destination terminal] [Figures 7 and 17; and col 8, lines 24-33 and lines 53-57].

11. As per claim 8, it is apparatus claimed of claim 1, it is rejected for similar reasons as stated above in claim 1.

12. As per claim 15, it is program product claimed of claim 1, it is rejected for similar reasons as stated above in claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 2, 3, 9, 10, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda [US Patent No 6,335,966], in view of Cartmell et al. [US Patent No 7,039,949].

14. As per claim 2, Toyoda does not disclose wherein the email display capability request includes a sender identification identifying the sender, and the method further comprises determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain. Cartmell discloses wherein the email display capability request includes a sender identification identifying the sender [i.e. identifying the sender] [col 5, lines 32-34; and col 8, lines 9-12], and the method further comprises determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain [i.e. authorized to send e-mail to the recipient] [Figure 9; col 3, lines 6-27; and col 7, lines 39-48]. It would have been obvious to combine the teaching of Toyoda and Cartmell because Cartmell's teaching of identifying sender and authorizing sender would allow to provide an authentication system that satisfy the authorization needs of recipients and determining whether to authorize the sender based on characteristic of the communication or sender [Cartmell, col 9, lines 48-67].

15. As per claim 3, Toyoda discloses finding at least one email display capability record for the domain further comprises finding, in dependence upon the domain identification and in dependence upon the connection address, at least on email display capability record for the domain [i.e. capability of destination terminal] [Figure 5; and col 6, lines 44-65].

Toyoda does not disclose finding, in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record, wherein:

the sender authorization record represents authorization for the sender to send email to a connection address in the domain;

the sender authorization record comprises sender authorization attributes including a connection address in the domain.

Cartmell discloses

finding, in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record [i.e. a web page that a recipient may use to view their list of authorized senders] [Figure 9, and col 7, lines 39-40], wherein:

the sender authorization record represents authorization for the sender to send email to a connection address in the domain [i.e. a list of senders who are currently authorized to send e-mail to the recipient] [Figure 9; and col 7, lines 40-46];

the sender authorization record comprises sender authorization attributes including a connection address in the domain [Figure 9; and col 7, lines 39-48].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Toyoda and Cartmell because Cartmell's teaching of a web page for authorizing senders would provide an interface for recipients to filter spam or unwanted emails.

16. As per claims 9 and 10, they are apparatus claimed of claims 2 and 3, they are rejected for similar reasons as stated above in claims 2 and 3.

17. As per claims 16 and 17, they are program product claimed of claims 2 and 3, they are rejected for similar reasons as stated above in claims 2 and 3.

18. Claims 4-7, 11-14, 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda [US Patent No 6,335,966], in view of Shaffer et al. [US Patent No 6,092,114].

19. As per claim 4, Toyoda does not specifically disclose the steps of:

receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object;

determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, wherein the determining results in a determination;

forwarding the email, including the digital object, to the email address, if the determination is that the digital object is not to be transcoded in the transcoding gateway; and

if the determination is that the digital object is to be transcoded in the transcoding gateway, carrying out the further steps of:

transcoding the digital object into a transcoded digital object; and

downloading the transcoded digital object to a destination client device.

Shaffer discloses the steps of:

receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object [i.e. receive a message at a local server and check file format of the attachment] [40, 42, Figure 2; and col 6, lines 6-30];

determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway [i.e. determine the access capability of the target client] [44, 46, Figure 2; and col 6, lines 31-65], wherein the determining results in a determination;

forwarding the email, including the digital object, to the email address, if the determination is that the digital object is not to be transcoded in the transcoding gateway [i.e. if the attachment is accessible without conversion, transmit to the target client] [46, 48, Figure 2; and col 6, lines 53-65]; and

if the determination is that the digital object is to be transcoded in the transcoding gateway [i.e. if determined that there is an incompatibility] [50, Figure 2; and col 6, lines 66-col 7, lines 11], carrying out the further steps of:

transcoding the digital object into a transcoded digital object [i.e. convert file format] [52, Figure 2; and col 7, lines 1-38]; and

downloading the transcoded digital object to a destination client device [i.e. transmit message to the target client] [48, Figure 2; and col 8, lines 48-59].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Toyoda and Shaffer because Shaffer's teaching of message conversion from one file format to a second file format at the server would reduce the time consuming for process large file attachment at the client device [Shaffer, col 4, lines 39-44].

20. As per claim 5, Toyoda does not specifically disclose

transcoding the digital object further comprises transcoding the digital object into a digital file having a digital format and a file name; and

downloading the transcoded digital object further comprise downloading the digital file to a destination client device at an internet address recorded in an internet address field of a client device record, the client device record having:

recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message, and,

recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file.

Shaffer further discloses wherein:

transcoding the digital object further comprises transcoding the digital object into a digital file having a digital format and a file name [i.e. convert file format and store at server] [70, Figure 3; and col 7, lines 63-col 8, lines 5]; and

downloading the transcoded digital object further comprise downloading the digital file to a destination client device at an internet address recorded in an internet address field of a client device record [i.e. router/server for routing of message to the target client] [48, 54 an 56, Figure 2; and col 3, lines 51-col 4, lines 19], the client device record having:

recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message [i.e. email mail box] [col 5, lines 47-50; and col 6, lines 6-18], and,

recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file [i.e. file extension, .BMP, .MPEG] [col 2, lines 43-65].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Toyoda and Shaffer because Shaffer's teaching of executing the conversion at the server would allow the process to complete off-line with respect to the user and the user's client device, this frees the resources of the client device to perform other tasks and often saves time for the user [Shaffer, col 3, lines 14-20].

21. As per claim 6, Toyoda does not specifically further disclose finding a capability record having a connection address equal to the email address. Shaffer further discloses finding a capability record having a connection address equal to the email address [i.e. sending party transmits email message to the mail server, the mail server forwards to the receiving party] [col 1, lines 23-35]. It would have been obvious to a persons skill in the art at the time the invention

was made to combine the teaching of Toyoda and Shaffer because Shaffer's teaching of mail server for forwarding email messages from sending party to receiving party would allow email messages to be provided to a correct party to protect data information.

22. As per claim 7, Toyoda does not specifically disclose forwarding the entire email, including the digital object, to an email client in another transcoding gateway in a client device. Shaffer further discloses forwarding the entire email, including the digital object, to an email client in another transcoding gateway in a client device [i.e. transmit request to remote server] [54, Figure 3; and col 7, lines 12-38]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Toyoda and Shaffer because Shaffer's teaching of transmitting request to remote server or another server would allow the remote server to perform the conversion in case the client and the local server is incapable of performing the necessary conversion, this would allow the system to be able to support conversion for multiple file formats.

23. As per claims 11-14, they are apparatus claimed of claims 4-7, they are rejected for similar reasons as stated above in claims 4-7.

24. As per claims 18-21, they are program product claimed of claims 4-7, they are rejected for similar reasons as stated above in claims 4-7.

25. As per claim 22, it is rejected for similar reasons as stated above in claims 1 and 4.

26. As per claims 23 and 24, they are rejected for similar reasons as stated above in claims 5 and 6.

27. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Follansbee John can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dustin Nguyen
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